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MAY 12 2006

OFFICE OF PETITIONS

In re Patent No. 6,985,255 :
SAITO : DECISION ON REQUEST
Issue Date: January 10, 2006 : FOR RECONSIDERATION OF
Application No. 09/867,472 : PATENT TERM ADJUSTMENT
Filed: May 31, 2001 : and
Atty Docket No. 00862.022249 : NOTICE OF INTENT TO ISSUE
: CERTIFICATE OF CORRECTION
:

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)" filed March 10, 2006. Patentees request that the Patent Term Adjustment for the above-identified patent be set at 913 days.

The request for reconsideration of the patent term adjustment indicated in the patent is GRANTED.

The patent term adjustment indicated in the patent is to be corrected by issuance of a certificate of correction showing a revised Patent Term Adjustment of nine hundred thirteen (913) days.

On January 10, 2006, the above-identified application matured into U.S. Patent No. 6,985,255. The instant request for reconsideration filed March 10, 2006 was timely filed within 2 months of the date the patent issued. See § 1.705(d). The Patent issued with a revised Patent Term Adjustment of 854 days. Patentees contend that there were no circumstances within this case history that constitute a failure by the Patentees to engage in reasonable efforts to conclude processing or examination of the above-identified application as set forth in 37 CFR § 1.704. In essence, Patentees' dispute the sole reduction of record, one for 59 days associated with the filing

of an information disclosure statement (IDS) received in the Office on August 22, 2005. Patentees state that the paper filed with the response to the notice of allowance was a second request for acknowledgement of consideration of previously cited prior art, and thus, no reduction is warranted.

In essence, Patentees contend that this Request for Acknowledgement of Consideration of Previously Cited Prior Art is an example of a submission after a Notice of Allowance that are not considered a failure to engage in reasonable efforts to conclude processing or examination of an application, in accordance with the "Clarification of 37 C.F.R. §1.704(c)(10) - Reduction of Patent Term Adjustment for Certain Types of Papers Filed After a Notice of Allowance Has Been Mailed," 1247 OG 111 (June 27, 2001).

Patentees' contention is well taken. The OG Notice states that:

... the Office is publishing this notice to provide guidance in interpreting the provisions of 37 CFR 1.704(c)(10) to clarify that submission of certain papers after a "Notice of Allowance," which do not cause substantial interference and delay in the patent issue process, are not considered a "failure to engage in reasonable efforts" to conclude processing or examination of an application. The following are examples of such papers: (1) Issue Fee Transmittal (PTOL-85B), (2) Power of Attorney, (3) Power to Inspect, (4) Change of Address, (5) Change of Status (small/not small entity status), (6) a response to the examiner's reasons for allowance, and (7) letters related to government interests (e.g., those between NASA and the Office). Therefore, the submission of these papers after a Notice of Allowance will not be considered a "failure to engage in reasonable efforts" to conclude processing or examination of an application and would not result in reduction of a patent term adjustment pursuant to 37 CFR 1.704(c)(10).

A Request for Acknowledgment of Consideration of Previously Cited Art is not among those examples. Example (6) refers to a Comment on the Examiner's Reasons for Allowance and does not encompass the instant papers.

Nonetheless, it is concluded that under the circumstances the filing of the Request for Acknowledgement of Consideration of

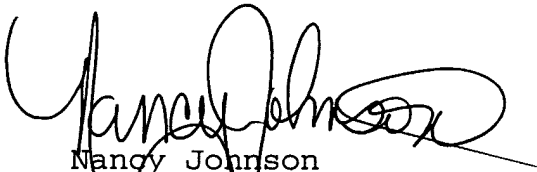
Previously Cited Prior Art for Priority Acknowledgment should not be considered "a failure to engage in reasonable efforts" to conclude processing or examination of an application and should not result in reduction of the patent term adjustment pursuant to 37 CFR 1.704(c)(10). Patentees have shown that an IDS citing seven references was originally submitted on March 22, 2004, as evidenced by a stamped postcard receipt. However as stated by the patentees, the non-final Office Action mailed February 24, 2005 did not attach an initialled copy of the IDS, indicating consideration of the references cited the IDS. In response to the non-final Office Action, the Remarks section of the Amendment filed on June 21, 2005 requested an initialled copy of the IDS, indicating that the references cited on the IDS had been considered. The Notice of Allowability mailed July 29, 2005 did not attach the requested initialled copy of the IDS. The Request for Acknowledgement of Consideration of Previously Cited Prior Art for Priority Acknowledgment filed on August 22, 2005 was, therefore, a second request for acknowledgement and should not be considered a failure to engage in reasonable efforts to conclude processing or examination of an application. The request filed on August 22, 2005 should also not be considered a §1.704(c)(10) paper because it is a copy of the previously filed IDS. Thus, it is concluded that the reductions totalling 59 days are not warranted.

In view thereof, the patent term adjustment indicated on the patent should be nine hundred thirteen (913) days.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application file is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction in order to rectify this error. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by NINE HUNDRED THIRTEEN (913) days.

Telephone inquiries specific to this matter should be directed to Denise Pothier at (571) 272-4787.



Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT : 6,985,255 B1

DATED : January 10, 2006

INVENTOR(S) : Toshiaki Saito

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 854 days

Delete the phrase "by 854 days" and insert – by 913 days--